

FROM

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PATENT APPLICATION

HEMLET-PACIFIC COMPANY
Intellectual Property Administration
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ATTORNEY DOCKET NO. 200210214-1

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Brian D. Oragg

Confirmation No.: 6126

Application No.: 10/624,911

Examiner: Marianne Cherry

Filing Date: 07/29/2003

Group Art Unit: 2198

Title: Storage Access System and Method for Image Forming Device

Mail Stop Appeal Brief - Patents
Commissioner For Patents
PO Box 1460
Alexandria, VA 22313-1460

TRANSMITTAL OF REPLY BRIEF

Transmitted herewith is the Reply Brief with respect to the Examiner's Answer mailed on 10/09/2007.

This Reply Brief is being filed pursuant to 37 CFR 1.183(b) with in two months of the date of the Examiner's Answer.

(Note: Extensions of time are not allowed under 37 CFR 1.135(a))

(Note: Failure to file a Reply Brief will result in dismissal of the Appeal as to the claims made subject to an expressly stated new ground rejection.)

No fee is required for filing of this Reply Brief.

If any fees are required please enclose Deposit Account DB-2025.

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Respectfully submitted,
Brian D. Oragg

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PATENT

Examiner: Mandocnee CHERY

Art Unit: 2188

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2. **Answer:** **False**

Attorney Docket No.:
202210214-1

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REPLY BRIEF under 37 CFR §41.41

This Reply Brief is timely provided within two months from the mailing date of the Examiner's Answer dated October 8, 2007.

CERTIFICATE OF FALSIFYING

I hereby certify that these papers are being transmitted to The United States Patent and Trademark Office under file number (571) 273-8300 on December 4, 2007.

Deum Polaris

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Docket No. 200210214-
Reply Brief dated December 4, 2007

Reply

In response to the Examiner's Answer, dated October 9, 2007, Appellant respectfully submits the following reply as permitted under 37 CFR §41.41(a)(1). The Examiner's Answer contained no new grounds of rejection and the present reply contains no new amendment, affidavit or other evidence. Thus a formal Brief is not required. The present reply supplements Appellant's Appeal Brief in view of the Examiner's Answer.

The following sections address the Examiner's Response to the Appeal Brief, which appears starting on page 16 and section "(10) Response to Argument." References to the Examiner's Answer will be cited as "EA."

§101 Rejection of claims 11-18

The Examiner's Answer begins with:

First of all, Examiner never used the terms "the article of manufacture" used in the claim as a basis for the rejection of the claims as being non-statutory under 35 USC 101.

(Examiner's Answer, page 16, last paragraph)

Since claim 11 explicitly recites the element "An article of manufacture," this term cannot be ignored in the analysis. The above-statement exemplifies the impropriety of the rejection. Suppose the claim recited "an antenna for generating and transmitting signals." An antenna is without question statutory subject matter. However under the present analysis, the claim would be rejected since the Examiner would not look to the term "antenna" but rather create a rejection based on selected terms from the claim like "signals." There is no authority that supports such a rationale.

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Independent claim 11 recites an article of manufacture embodied in a computer-readable medium that comprises processor executable instructions. Claim 11 is not a signal claim as the Examiner's Answer describes (see pages 16-19 referring to "a claimed signal"). Claim 11 is statutory subject matter for the reasons stated in Appellant's Brief (see MPEP 2106.01, section I, para. 2: "...a claimed computer-readable medium encoded with a computer program is a computer element ... and is thus statutory," citing *Lowry*, 32 F.3d at 1583-84, 32 USPQ2d at 1035). The present §101 rejection is misapplied and unsupported by the MPEP and case law. The rejection should be reversed.

Whether Claims 1-27 are unpatentable under 35 U.S.C. §103(a) as being unpatentable over McIntyre (2003/0063305) in view of Quino (2004/0026616).

Independent Claim 1

The Examiner's Answer appears to set forth the criteria for a proper rejection as: "It suffices that the prior art discloses the claimed subject matter at least in the manner recited in applicants' specification." (EA, page 20, last paragraph). This is not the criteria stated in 35 U.S.C. §102 or §103.

The Examiner's Answer then looks to the present specification, cites paragraph [0016], and underlines the word "may" from the phrase, "may compete for access." (EA page 21, first paragraph). Then the Response states that "it is readily apparent that the computing devices or client devices of McIntyre may compete for access to the data storage device..." (EA, page 21, first paragraph). It appears that the reasoning applied misunderstands the specification and the claimed features. For example, when the present specification states that devices may compete for access, whether the devices compete depends on timing. If two devices request access at separate times, they will not compete. If the requests are simultaneous, they will likely compete. Thus the word "may" in the specification is accurate.

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But the claims do not simply claim "competing for access" and it is not enough that a reference discusses "competing for access." This does not support a proper rejection. Thus the Examiner's emphasis on the term "may" from the present specification is unclear since it provides no additional support to the rejection or to the teachings of the references.

Additionally, McIntyre may well have devices that compete for access. However, the cited sections of McIntyre fail to disclose ways for controlling such situations and fail to teach the particular elements of the claims. Furthermore, the Examiner still maintains that McIntyre teaches "at least one protocol or device does not provide notice of the access to the other protocol or device..." (EA, page 21, bottom of first paragraph). No such teaching exists in cited paragraphs [0022 - 0023]. The statement of "different message type/formats" from Quinn [0047] also does not teach the present claim elements. The generic term "different" protocols fails to teach or suggest the types of protocols such as "coordinating" and/or "uncoordinating", and fails to teach a system or process for handling such protocols and access requests in the manner claimed. "Different protocols" can be different coordinating protocols each of which provides notice of access to each other. Thus the interpretation of "does not provide notice of the access to the other protocol or device" is created by the Office Action since it is unsupported by the references.

For the reasons set forth in Appellant's Brief, a prima facie rejection has not been established and the rejection should be reversed.

Independent Claim 11:

The Examiner's Answer alleges that Quinn [0047] teaches the claimed element relating to the first communication protocol does not provide notice of an access to the second communication protocol (EA, page 22, line 1). Appellant has again reviewed [0047] and finds no such teaching. Furthermore Appellant finds no teaching of handling simultaneous access requests or requests coming from the types of protocols claimed.

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Thus Quinn [0047] fails to teach or suggest an article of manufacture comprising processor instructions for handling simultaneous access requests for such protocols as recited in claim 11. The reliance on Quinn is not on point and fails to support a prima facie obviousness rejection. The rejection is improper and should be reversed.

The Examiner's Answer also relies on the AddVolume agent of Quinn [0052] (EA, page 23 first paragraph). Quinn [0052] describes the AddVolume agent as:

"the AddVolume agent is configured to perform operations related to adding a volume to a storage array."

(Quinn [0052] lines 2-4 (emphasis added))

In the context of computer systems, the term "volume" is used to describe a disk drive (See for example, Wikipedia on-line encyclopedia for the term "volume"). Thus in paragraph [0052], Quinn discloses an AddVolume agent that can add a disk drive to a storage array. Adding a volume to a storage array has nothing to do with the present claims. Quinn [0052] is not on point and thus fails to support the rejection. Furthermore when adding a volume, gaining exclusive access or locking the storage array as discussed by Quinn, has nothing to do with the present claims. One of ordinary skill in the art understands that adding a volume to a storage array is irrelevant to the features of claim 11. The combination of McIntyre and Quinn fail to establish a prima facie obviousness rejection. All rejections based on this combination are improper and should be reversed.

Independent Claim 20

Claim 20 was rejected simply by incorporating the rationale from the rejection of claims 1, 4 and 11 (Final Office Action, bottom of page 19). The specific elements from claim 20 were not addressed. In the Examiner's Answer, claim 20 was addressed by referring to the comments of claim 11 (EA, page 24, third paragraph). A prima facie obviousness rejection of claim 20 has not been established for the reasons set forth in Appellant's Appeal Brief. The rejection should be reversed.

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Hindsight Reconstruction

In response to Appellant's argument that the obviousness rejection is based on hindsight reconstruction, the Examiner's Answer replies with a form paragraph from the MPEP and cites In re McLaughlin (E.A. page 24, second paragraph). However, no evidence or reasoning is provided that rebuts Appellant's position. As explained above and in Appellant's Brief, a number of claimed features are not disclosed by the references. However, those features are being interpreted into the teachings of the references and this interpretation is made using knowledge gleaned from applicant's disclosure. The reconstruction is improper. Thus the rejections are improper and cannot stand.

Conclusion

Appellant respectfully maintains all previous arguments, which show the deficiencies in the rejections, along with the additional comments submitted herein. Accordingly, Appellant respectfully requests that the Board of Appeals overturn all rejections and allow all pending claims.

Respectfully Submitted,



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